

REMARKS

In the Office Action, the Examiner rejected claims 1, 2, 4-9, 11-14, 26 and 27. In this paper, Applicants amended claim 1. Upon entry of the amendment, claims 1, 2, 4-9, 11-14, 26 and 27 remain pending in the present patent application. Accordingly, Applicants respectfully request reconsideration and allowance of all pending claims in view of the foregoing amendments and the following remarks.

Rejections Under 35 U.S.C. §102

The Examiner rejected claims 1, 2, 4, 6-9, and 12-14 under 35 U.S.C. §102(e) as being anticipated by Bydalek (U.S. Pat. No. 6,435,791). Applicants respectfully traverse this rejection. As discussed in detail below, the cited references not anticipate the foregoing claims.

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Thus, if the claims recite even one element not found in the cited reference, the reference does not anticipate the claimed invention.

First, each of the independent claims 1, 7, 13, 26, and 27 recite a standoff portion. Applicants respectfully submit that Bydalek does not disclose a “standoff,” as recited in the instant claims. Applicants remind the Examiner that, during patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *See In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA

1969); *see also In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997); *see also* M.P.E.P. §§ 608.01(o) and 2111. Interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *See In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999); *see also* M.P.E.P. § 2111. As further explained in Section 2111.01 of the M.P.E.P., the words of the claim must be given their plain meaning unless the applicant has provided a clear definition in the specification. *See In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Again, the plain meaning refers to an interpretation by those of ordinary skill in the art. *See In re Sneed*, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983).

In the Office Action, the Examiner equated the frustoconical undersurface (36) of the pressure ring (16) with the standoff recited in the instant claims. Applicants respectfully stress that the Examiner's proposed scope for the term "standoff" is completely unreasonable and inconsistent with the scope of the specification and the understanding of one of ordinary skill in the art. One of ordinary skill in the art would not interpret "standoff" to include a pressure ring or frustoconical undersurface, as disclosed by the Bydalek reference. Pressure rings are completely different and outside the reasonable scope of a "standoff," as set forth in the instant claims. The Bydalek reference discloses a pressure ring (16) with a frustoconical-shaped undersurface (36), which mates with a corresponding depression (38) in a wheel surface (40). *See* Bydalek, Column 2, Lines 56-59. The purpose of the shape of the pressure ring (36) and corresponding shape of the wheel surface depression (38) is to provide a centering force to align the wheel surface depression (38) with the center of the wheel fastener assembly (10). *See* Bydalek, Column 3, Lines 5-11. The disclosed pressure ring (36) is neither illustrated nor described as a standoff. In addition, the function of the pressure ring (36) is not remotely suggestive of a standoff as understood by one of ordinary skill in the art. If further understanding of a standoff is desired, then Applicants direct the Examiner

generally to page 5 of the present application. In view of the omitted standoff portion, the cited reference cannot anticipate the instant claims.

Second, claim 1 recites that the standoff portion of the stemmed washer is “configured to extend substantially through material of a defined thickness and *substantially limit compressive loading on the material.*” The Bydalek reference does not disclose this claim feature as a property of the pressure ring. The Bydalek pressure ring is designed to impart a centering force onto the wheel surface. *See* Bydalek, Column 3, Lines 8-11. The pressure ring (16) exerts a centering force on the wheel surface, but it cannot simultaneously limit compressive loading on the wheel surface. Therefore, Applicants respectfully submit that the Bydalek reference does not disclose a standoff portion designed to “substantially limit compressive loading on the material.”

Regarding independent claims 7 and 13, these claims further recite that the standoff *limits displacement* of a threaded fastener relative to the attached washer. The Bydalek reference does not disclose that the pressure ring limits displacement of a threaded fastener with respect to the washer. In the Office Action, the Examiner summarily rejected these claims in view of Figure 5, yet the Examiner did provide clear support for the rejection as it pertains to the standoff *limiting displacement*. Applicants remind the Examiner of the requirement to provide clear explanations of all rejections, as set forth in 37 C.F.R. § 1.104 and M.P.E.P. § 707.07.

If the Examiner believes these claim features to be inherent, then the Examiner is reminded that the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999) (Emphasis Added). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of

inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner, in presenting the inherency argument, bears the evidentiary burden and must adequately satisfy this burden. *See id.* Regarding functional limitations, the Examiner must evaluate and consider the functional limitation, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. *See* M.P.E.P. § 2173.05(g); *In re Swinehart*, 169 U.S.P.Q. 226, 229 (CCPA 1971); *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997). If the Examiner believes the functional limitation to be inherent in the cited reference, then the Examiner “must provide some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Inter. 1986).

The cited reference does not support a conclusion that the pressure ring (16) has any features functioning to limit displacement, or even that the prior art configuration would or could have that effect. In view of the foregoing case law, Applicants further emphasize that the disposition of the pressure ring (16) in the cited reference does not support the conclusion that limited displacement would *necessarily* occur. As stated above, the mere *possibility* that limited displacement *may* occur in the cited art is not sufficient to support the conclusion that the feature is “inherent.” One of ordinary skill in the art would simply have no reason or motivation to modify the cited reference to limit displacement, nor would a skilled artisan recognize the possibility of limiting displacement based on the much different functionality of the pressure ring (16).

The Appellant further stresses that the *drawings* of the cited reference must be evaluated for what they *reasonably disclose and suggest* to one of ordinary skill in the

art. *See In re Aslanian*, 590 F.2d 911, 200 U.S.P.Q. 500 (CCPA 1979). The Examiner apparently believes Figure 5 illustrates certain features recited in the instant claims, yet this figure only discloses a single nut (44) and the pressure ring (16) adjacent a wheel surface (40). This figure fails to disclose engagement between two threaded fasteners, much less limited displacement of an externally threaded fastener (or bolt) secured to an internally threaded fastener (or nut), as recited in the instant claims. For these reasons, the Examiner's rejection based on Figure 5 is completely improper and unsupported.

Accordingly, Applicants stress that the Bydalek reference does not anticipate independent claims 1, 7, and 13. The claims depending from independent claims 1, 7, and 13 are also believed to be patentable over the cited reference by way of their dependencies on these claims and by way of further unique features recited in each respective claim. For these reasons, Applicants request the Examiner withdraw all outstanding rejections under 35 U.S.C. §102(e).

Rejections Under 35 U.S.C. §103

The Examiner rejected claims 1, 2, and 4-6 under 35 U.S.C. §103(a) as unpatentable over the Goiny reference (U.S. Pat. No. 4,969,788). Applicants respectfully traverse this rejection.

First, as discussed in detail above, independent claim 1 recite a standoff portion. Applicants respectfully submit that Goiny does not disclose a "standoff," as recited in the instant claim. Applicants also reiterate that, during patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *See* M.P.E.P. §§ 608.01(o) and 2111. Interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *See* M.P.E.P. § 2111.

In the Office Action, the Examiner equated the spherically shaped underside (14) of the pressure ring (12) with the standoff recited in the instant claim. Again, Applicants respectfully stress that the Examiner's proposed scope for the term "standoff" is completely unreasonable and inconsistent with the scope of the specification and the understanding of one of ordinary skill in the art. One of ordinary skill in the art would not interpret "standoff" to include a pressure ring, as disclosed by the Goiny reference. Pressure rings are completely different and beyond the reasonable scope of a "standoff," as set forth in the instant claims. The Goiny reference discloses a pressure ring (12) with a spherically shaped undersurface (14), which mates with a corresponding depression (16) in a component (6). *See* Goiny, Column 3, Lines 40-50. The disclosed pressure ring (12) is neither illustrated nor described as a standoff. In addition, the function of the pressure ring (12) is not remotely suggestive of a standoff as understood by one of ordinary skill in the art. Again, Applicants direct the Examiner generally to page 5 of the present application for a better understanding of a standoff. In view of the omitted standoff portion, the instant claim is believed to be patentable over the cited reference.

Second, claim 1 recites that the standoff portion of the stemmed washer is "configured to ... *substantially limit compressive loading on the material.*" The Goiny reference does not disclose this claim recitation as a property of the pressure ring. The Goiny pressure ring (12) is designed to impart a particular, reproducible hold down force on the component surface. *See* Goiny, Column 1, Line 66 – Column 2, Line 4. The pressure ring cannot exert a particular, reproducible hold down force on the component surface while simultaneously limiting compressive loading on the component surface. Therefore, Applicants respectfully submit that the Goiny reference does not disclose a standoff portion designed to "substantially limit compressive loading on the material," as recited in the instant claim. In view of the omitted standoff portion, the instant claim is believed to be patentable over the cited reference.

The Examiner rejected claims 5 and 11 under 35 U.S.C. § 103(a) as unpatentable over Bydalek in view of Goiny. As discussed above, neither Bydalek nor Goiny discloses a standoff as recited in the present claims. Accordingly, Applicants respectfully submit that dependent claims 5 and 11 are patentably distinct from the Bydalek and Goiny references taken alone or in combination.

The Examiner rejected claims 26 and 27 under 35 U.S.C. § 103(a) as unpatentable over Bydalek in view of Hans (U.S. Pat. No. 3,829,163). As discussed above, the Bydalek reference does not disclose a standoff as contemplated by the present claims. Moreover, the Hans reference fails to obviate the deficiencies of the primary reference. The Applicants further emphasize the Examiner's failure to provide any motivation or suggestion to combine the references. Applicants stress that the Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *See In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Accordingly, Applicants respectfully submit that independent claims 26 and 27 are patentably distinct from the Bydalek and Goiny references taken alone or in combination.

For these reasons, Applicants stress that the independent claims 1, 26, and 27 are patentable over the cited references. The claims depending from independent claim 1 are also believed to be patentable over the cited references by way of their dependencies on claim 1 and by way of further unique features recited in each respective claim. Accordingly, Applicants request the Examiner withdraw all outstanding rejections under 35 U.S.C. §103.

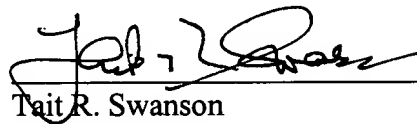
Conclusion

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to

clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: September 25, 2003

A handwritten signature in black ink, appearing to read "Tait R. Swanson", is written over a horizontal line.

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